

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew H. Robbins Art Unit : 3688
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REPLY BRIEF

This document is submitted in response to the Examiner's Answer ("Answer"), mailed April 15, 2011, to Appellant's Appeal Brief ("Appeal Brief").

SECTION 103 REJECTION OF INDEPENDENT CLAIMS 1, 26, 41, AND 44

On page 42 of the examiner's answer, the examiner agrees that the prior art card expires at the end of a term, regardless of whether or not it is ever actually used. The examiner then states that this fact is irrelevant to the claim because the claim imposes no limitations on card expiration.

The examiner has misunderstood. Applicant is not trying to distinguish the art on the basis of expiration date. The fact that the prior art card expires at the end of the term is merely evidence of the fact that the prior art card represents an option contract granting the holder the right to collect three meals a day at set mealtimes during the course of a term.

This is substantially different from the claimed method, in which, because information representing the meal is in the card, the meals can be had in any combination at any time.

As an glaring example, consider a first holder, who holds the prior art card at the beginning of a ten-week term. He has the right have, for example, 150 meals. If this first holder wanted to throw a party for 150 guests, he could not use his card. Why not?

Because the prior art card grants the first holder one meal at breakfast, one meal at lunch, and one meal at dinner, every day for the term.

Compare this with the experience of a second card holder who holds Applicant's card, with information representing 150 meals stored thereon. Nothing stops this second card holder from throwing a party for 150 guests.

This difference between the way the prior art card works and the way Applicant's card works arises because they store different things. The prior art card stores the right to have one and only one meal at each mealtime throughout the term. Applicant's card can be viewed as storing the physical product itself. Thus, Applicant has no such time-based restrictions.

While the foregoing difference may seem subtle, it has a huge effect on the way the cards are used.

For example, if the first holder becomes sick for half the term and misses 75 meals, he can no longer collect those meals. They are lost. This is because the prior art card never contained the meals themselves. It only contained an option to take those meals. Because the first holder did not take those meals when offered, the option lapsed.

This difficulty would not befall a second user. If the second user misses half the term, he still has those 75 meals on his card. Thus, the second user will return with 150 meals still left on his card, which, as noted above, he can then use all at once to throw a party to celebrate his return.

This distinction between the prior art card and Applicant's is apparent from claim 1's limitation of "adding, by a computer, the one or more pre-paid physical products to an account associated with the physical card." This is different from the prior art, which at best discloses "adding... a *time-limited option* to consume pre-paid physical products."

A “meal plan” is not a physical product

On page 43 of the Answer, the examiner mischaracterizes Applicant’s argument on pages 10-12 of the Appeal Brief. Applicant did not argue that a meal was not a physical product. Instead, Applicant argued that a meal plan was not a physical product.

A smart card’s memory is not a “central database”

On page 43 of the Answer, the examiner asserts that in the prior art card, the central database is actually stored on the card itself.

Before one can say something is “central”, there must be something that that thing is central relative to. For example, a center of a circle is only a center because one has defined a circle. Otherwise it is just like any other point.

To the extent the set of registers on the smart card can even be regarded as a “database” at all, that set of registers is not “central” to anything. They are no more “central” to anything than the set of registers on another person’s smart card.

Moreover, Applicant disputes the notion that the set of registers on the prior art card would even be regarded as a “database.” The examiner’s interpretation of database appears to encompass anything that can store data. Thus, under the examiner’s construction, there would be nothing to stop a single flip-flop from being a “database.” After all, the state that a flip-flop is in is clearly “data” which is in some sense stored by that flip-flop.

A definition of “database” that includes within its scope anything whatsoever that can store data is plainly far too broad to be reasonable.

The examiner has provided no factual evidence to support the dubious proposition that one of ordinary skill in the art would have viewed a set of registers as shown in the prior art card as being a “database.” Instead, the examiner merely says that it is so. This is not so much a finding of fact as an inventing of a fact. Accordingly, the examiner’s factual finding that one of ordinary skill in the art would have regarded the 15 registers in FIG. 1 of Greer as a “database” is not supported by any substantial evidence of record.

SECTION 103 REJECTION OF DEPENDENT CLAIMS 3 AND 5

Claim 3 requires that the products placed on a smart card be associated with a specific SKU. Claim 5 is similar.

On page 45, the examiner draws attention to Greer col. 1, lines 32-39, which discusses certain prior art smart cards that provide information to be used in re-stocking shelves.

The above discussion has nothing to do with the smart cards that the examiner proposes to modify to include the subject matter of claims 3 and 5. According to Greer, these known smart cards are not for pre-paid meal plans.

Moreover, the mere fact that items on a food storage area have an associated SKU is not a reason for one of ordinary skill in the art to modify Greer's smart card so that it includes products tied to an SKU. To the extent Greer's smart card stores information about a meal (which it does not), that meal would be a conglomeration of various ingredients from food storage shelves. Although each of these ingredients may have an SKU, the meal itself does not.

The examiner's argument would be more compelling if, for example, Greer's smart card stored something that might reasonably have an SKU, for example, a jar of pickles. But it does not. According to the examiner, Greer's smart card stores meals. One of ordinary skill in the art would not regard a meal as the sort of thing that would have an SKU.

SECTION 103 REJECTION OF DEPENDENT CLAIM 10

Claim 10 recites the additional limitation of "sending to the second terminal a message showing the pre-paid products in the account."

On page 45 of the Answer, the examiner asserts that when the POS reads a smart card, the smart card sends a message to the POS.

This does not appear to be the case. As best understood, the smart card is simply being read by the POS. It does not engage in the act of sending. In fact, the smart card as disclosed does not even have a power source that it could use to engage in the act of sending anything.

SECTION 103 REJECTION OF DEPENDENT CLAIMS 12, 13, AND 14

Claim 12 recites the additional limitation of “adding... a pre-paid discount.”
Claims 13 and 14 recite a similar limitation.

The examiner concedes that this limitation is not disclosed by the cited combination of references. On page 46, the examiner explains that one of ordinary skill in the art would have done so “to encourage the student to obtain more meals at the beginning of the semester at a cheaper rate.”

The examiner’s proposed motivation to modify Greer to include a pre-paid discount makes little sense. The examiner appears to be proposing that the student will sign up for a meal plan that provides, for example, 200 meals instead of 150 meals during a 10 week semester, simply because a pre-payment discount would reduce the amortized cost. But one of ordinary skill in the art would obviously have understood that a student only needs three meals a day and would have no reason to purchase a plan with more meals than he needs simply because the amortized cost per meal is somehow less.

The examiner may also be proposing the idea that offering a discount for pre-payment in Greer’s system would have been obvious.

To the extent this is the case, then the implication is that Greer does *not* already disclose a system in which meals are pre-paid. Since the examiner relies on Greer disclosing pre-paid meals in rejecting claim 1, the examiner’s proposed motivation to modify Greer would appear to undermine the examiner’s position on claim 1.

On the other hand, if, consistent with the examiner’s position in claim 1, then the proposed modification would make even less sense. In that case, the offer being made to

the student would essentially be “If you pay in advance for the meals associated with your pre-paid smart card, we will offer you a pre-payment discount.” In other words, the student would obtain a discount for doing something that he had to do anyway just to obtain the card in the first place.

In view of the foregoing arguments, the examiner has failed to provide a plausible basis for modifying the references. Accordingly, no prima facie case of obviousness has been made.

SECTION 103 REJECTION OF CLAIMS 18 AND 48

In rejecting claim 10, the examiner has clarified precisely what he views as transmission and reception of a message. The examiner appears to be of the opinion that when a POS terminal reads the smart card, the smart card “sends” a message to the POS terminal, which then “receives” this message.

However, if this is the case, then the only data that the smart card can send to the POS terminal is whatever is in its fifteen registers, which are shown in FIG. 1.

Claim 18 requires that the received message indicate “that one or more pre-paid products have been added to the check.”

Obviously, the expiration date and last transaction date in registers 1-4 would not indicate that pre-paid products have been added to a check. The operator ID in register 36 is likewise irrelevant to determining that pre-paid products have been added to a check. Registers 5-12 are merely numerical quotas, i.e. how many meals are available. The POS terminal would not be able to determine from these if a pre-paid product has been added to a check. Nor would a POS terminal be able to use this information to perform the check level reconciliation that includes automatically removing products that have been added to the check but not paid for, as required by claim 18.

The examiner states that Greer keeps track of meals used, D'Arbeloff discloses handling electronic payments, and Toth discloses a payment system used in restaurants. But these are not the same as the specific limitations of claim 18.

The examiner may not assert that a claim is obvious by simply making general statements concerning the broad subject matter of the references. He must identify where the references, in combination, teach or suggest the claimed subject matter. The examiner has failed to do so. Accordingly, there the examiner has not made a prima facie case of obviousness for claim 18 or claim 48.

SECTION 103 REJECTION OF CLAIM 20

Claim 1 recites a "first terminal" from which one receives: (1) information indicating that a physical product has been prepaid, (2) information indicating that a payment specific to the one or more pre-paid physical products has been made; and (3) a unique identifier that is used to identify a physical card. Claim 20 recites a further limitation on this first terminal, namely that it be not just any terminal but a "remote network terminal."

On page 45 of the Answer, in connection with rejecting claim 10, the examiner has clarified his position on where exactly the Office finds the act of sending and receiving messages between terminals occurs. Specifically, the examiner views the reading of a smart card by a POS terminal as being equivalent to sending a message from one terminal to another.

Obviously, if the first and second terminals are the smart card and the POS terminal, neither one can reasonably be regarded as a "remote network terminal." The smart card is presumably just swiped through the POS terminal. Far from being remote from each other, the smart card and POS terminal are in intimate contact. Moreover, there is no network involved in the alleged message transmission that occurs when one swipes the smart card through the POS terminal.

On page 46 of the Answer, the examiner simply states that the additional limitation of claim 20 “is disclosed and/or rendered obvious by the evidence relied upon.”

According to KSR,

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”¹

A general statement that a particular claim limitation is “is disclosed and/or rendered obvious by the evidence relied upon.” is precisely the sort of conclusory assertion of an ultimate legal conclusion.

In the appeal brief, Applicant explained carefully why the two passages relied upon did not disclose the additional limitation of claim 20. The examiner’s bald and sweeping assertion that the limitation is nevertheless disclosed and/or rendered obvious by the evidence relied upon” is no rebuttal at all.

The examiner has thus far not identified any specific structures in the art that would correspond to the “first server” of the claim, let alone a structure that is also “a remote network terminal” as the claim requires.

The examiner further states that “remote network” in “remote network terminal” is non-functional descriptive material.

This is not the case. A terminal that is a “remote network” terminal is structurally different from other terminals because a “remote network terminal” should at least include some type of network interface. Therefore, the modifier “remote network” is not merely “non-functional descriptive material.”

Moreover, the cited cases, *Gulack, Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship

¹ *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

with some substrate. A limitation that a terminal is a remote network terminal has nothing to do with this issue.

SECTION 103 REJECTION OF CLAIM 21

Claim 21 recites the additional limitation that the first terminal be a kiosk.

Applicant pointed out, in the Appeal Brief, that the two passages as allegedly disclosing a kiosk: col. 1, lines 49-53 and col. 3, lines 20-25, describe the existence of a POS terminal, but that nothing suggested that the POS terminal comprises a kiosk.

On page 47, the examiner states that “a computer is interpreted to be a kiosk.”

Applicant agrees that a kiosk may contain a computer within it. But the fact that a kiosk may contain a computer in it does not make the computer and the kiosk the same thing. The fact that one thing can contain another does not make the two things the same.

Applicant recognizes that the examiner is entitled to apply the broadest reasonable interpretation to a claim during prosecution. However, that interpretation must be consistent with how those of ordinary skill in the art would understand the claim.

In the present case, the examiner has not provided any factual evidence to support the proposition that one of ordinary skill in the art would regard a computer as a kiosk.

SECTION 103 REJECTION OF DEPENDENT CLAIMS 46-47

Both claims 46 and 47 require “transferring money from a first legal entity that owns the first terminal to a second legal entity that owns the second terminal,” with the distinction between the claims arising from the circumstances of the transfer.

The examiner alleges that this claim limitation is disclosed in *Greer*’s abstract and also at col. 3, lines 3-10 of *Greer*. But neither of these passages addresses ownership of different terminals. Neither passage teaches or suggests that two terminals are owned by different legal entities as the claim requires.

On page 48 of the Answer, the examiner simply states that the additional limitation of claims 46-47 are “disclosed and/or rendered obvious by the evidence relied on.”

According to KSR,

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”²

A general statement that a particular claim limitation is “is disclosed and/or rendered obvious by the evidence relied upon.” is precisely the sort of conclusory assertion of an ultimate legal conclusion.

The examiner further states, on page 48 of the Answer, that Greer and D’Arbeloff both disclose “transaction settlement.”

This, however is not the limitation at issue. A general statement that references disclose “transaction settlement” is not a disclosure of the specific additional limitations of claims 46-47.

In the Answer at page 46, the examiner also states that ownership of terminals is “non-functional descriptive material.”

In response, Applicant points out that ownership of a terminal is important in determining who can and cannot access that terminal, and the manner in which that terminal can be accessed. Accordingly, the examiner may not read that limitation out of the claim.

Moreover, the cited cases, *Gulack*, *Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship with some substrate. A limitation concerning ownership of a terminal has nothing to do with this issue.

² *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Accordingly, *Greer* fails to disclose or suggest at least this limitation of claims 48 and 49. As the secondary reference does nothing to remedy this deficiency in *Greer*, the combination of references likewise fails to disclose or suggest this limitation.

SECTION 103 REJECTION OF DEPENDENT CLAIM 49

Claim 49 recites limitations on two different POS terminals. Specifically, the claim requires that the first terminal include:

a first point-of-sale terminal having access to a first point-of-sale database having information about products that are available for purchase or redemption at the first point-of-sale terminal,

and the second terminal include:

“a second point-of-sale terminal having access to a second point-of-sale database having information about products that are available for purchase or redemption at the second point-of-sale terminal,

Claim 49 further imposes restrictions on access to the POS databases. Specifically:

the first point-of-sale terminal does not have access to the second point-of-sale database, and the second point-of-sale terminal does not have access to the first point-of-sale database

On page 49 of the Answer, the examiner points out that the references disclose multiple computers and the use of databases.

While this may be true, this is not the claim limitation. The mere fact that certain references happen to refer to more than one computer and that they refer to databases does not disclose or suggest the specific limitation of claim 49 as set forth above.

The examiner further states, on page 50 of the Answer, that “whether a database has access to information is non-functional descriptive material.”

First of all, this is not even the claim limitation at issue. The claim refers to point-of-sale terminals that access information, and not to databases that access information.

Secondly, the fact that a POS terminal has access to a POS database having information about products available for purchase or redemption at that terminal is far from non-functional. Such a POS terminal will be able to do things that other POS terminals cannot do. For example, such a POS terminal would be able to read and possibly write information to such a database in a way that a POS terminal lacking such access would be unable to do.

Moreover, the cited cases, *Gulack*, *Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship with some substrate. A limitation concerning access to databases has nothing to do with this issue.

SECTION 103 REJECTION OF DEPENDENT CLAIM 50

Claim 50 recites limitations on two different POS terminals. Specifically, claim 50 requires that the first terminal include:

a first point-of-sale terminal having access to a first point-of-sale database having information about products that are available for purchase or redemption at the first point-of-sale terminal,

and that the second terminal include:

“a second point-of-sale terminal having access to a second point-of-sale database having information about products that are available for purchase or redemption at the second point-of-sale terminal,

Claim 50 further imposes restrictions on products available at each POS. Specifically:

at least some of the products that are available for redemption at the second point-of-sale terminal are different from the products that are available for purchase at the first point-of-sale terminal

The examiner alleges that these limitations are all disclosed either in the abstract or at col. 3, lines 3-10 of *Greer*. But neither of those passages ever refers to a POS as having its own associated database. Nor do those passages ever refer to different products

being available from different POS terminals. Thus, the cited passages have little relevance to the claim limitation.

On page 50 of the Answer, the examiner points out that the references disclose multiple computers and the use of databases.

While this may be true, this is not the claim limitation. The mere fact that certain references happen to refer to more than one computer and that they refer to databases does not disclose or suggest the specific limitation of claim 50 as set forth above.

The examiner further states, on page 51 of the Answer, that “whether a database has access to information is non-functional descriptive material.”

First of all, this is not even the claim limitation at issue. The claim refers to point-of-sale terminals that access information, and not to databases that access information.

Secondly, the fact that a POS terminal has access to a POS database having information about products available for purchase or redemption at that terminal is far from non-functional. Such a POS terminal will be able to do things that other POS terminals cannot do. For example, such a POS terminal would be able to read and possibly write information to such a database in a way that a POS terminal lacking such access would be unable to do.

SECTION 103 REJECTION OF DEPENDENT CLAIM 51

Claim 51 recites two different POS terminals in which the first POS terminal enables a customer to redeem a pre-paid product that was added to the customer's account from a second POS terminal. This second POS terminal includes a corresponding POS database with information about products available at the second POS terminal.

The cited text (abstract and col. 3, lines 3-10) does not describe two POS terminals, with redemption at a first terminal of a pre paid product that was added a second terminal. Instead, the cited text describes certain administrative steps associated

with setting up smart cards, as well as details on the quota system used to restrict the card user's access to meals. This plainly has nothing to do with the claim limitation.

On page 52 of the Answer, the examiner points out that the references disclose multiple computers and the use of databases.

While this may be true, this is not the additional claim limitation for claim 51. The mere fact that certain references happen to refer to more than one computer and that they refer to databases does not disclose or suggest the specific limitation of claim 51 as set forth above.

The examiner further states, on page 52 of the Answer, that "whether a database has access to information is non-functional descriptive material."

First of all, this is not even the claim limitation at issue. The claim refers to redemption of pre-paid products, and not to databases that access information.

Moreover, the cited cases, *Gulack*, *Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship with some substrate. A limitation concerning access to a database has nothing to do with this issue.

SECTION 103 REJECTION OF DEPENDENT CLAIM 52

Claim 52 requires two POS databases with non-overlapping content.

The cited text (abstract and col. 3, lines 3-10) does not describe POS databases, let alone whether or not their content overlaps. Hence, the cited text has nothing to do with the additional limitation of claim 52.

On page 52 of the Answer, the examiner simply states that the additional limitation of claim 52 is "disclosed and/or rendered obvious by the evidence relied on."

According to KSR,

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”³

A general statement that a particular claim limitation is “is disclosed and/or rendered obvious by the evidence relied upon.” is precisely the sort of conclusory assertion of an ultimate legal conclusion.

On page 52 of the Answer, the examiner points out that the references disclose multiple computers and the use of databases.

While this may be true, this is not the claim limitation. The mere fact that certain references happen to refer to more than one computer and that they refer to databases does not disclose or suggest POS databases with non-overlapping content.

The examiner further states, on page 53 of the Answer, that “databases with non-overlapping content is non-functional descriptive material.”

In fact, this limitation is more than non-functional. Databases with overlapping content are different from databases with non-overlapping content because databases with overlapping content may include common data whereas the databases with non-overlapping content cannot have data in common.

Moreover, the cited cases, *Gulack*, *Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship with some substrate. A limitation concerning whether databases have overlapping content has nothing to do with this issue.

SECTION 103 REJECTION OF DEPENDENT CLAIM 45

Claim 45 requires that the request to add pre-paid products to an account be sent from a POS terminal.

³ *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

In *Greer*, the computer that configures a smart card and adds information about a meal plan is not a POS terminal. According to *Greer*, POS terminals read a smart card, and determine whether a meal can be dispensed. If a meal is to be dispensed, the POS terminal also updates a count so that the customer does not obtain more meals than he should. This does not amount to adding a pre-paid product to the smart card.

On page 53 of the Answer, the examiner says that in *Greer*, students add meals and meal plans to their cards via a computer.

First of all, it is unclear whether this is factually correct. Applicant is unable to find anything in *Greer* that refers to students adding meals and meal plans to their cards.

Secondly, even if it were factually correct, this would not be the claim limitation. The claim requires that a request to add pre-paid products to an account be sent from a POS terminal. This is different.

SECTION 103 REJECTION OF INDEPENDENT CLAIMS 32, AND 53-55

Claim 32 recites numerous limitations similar to those recited by claim 1. For those limitations, Applicant re-asserts the corresponding arguments made in connection with claim 1.

Claim 32 includes the further limitation of

“using a set of rules to verify that the second physical product is within the family of specific physical products represented by the first physical product.”

Toth discloses, in FIG. 2, buttons with labels for product families, such as “Beverages.” Clicking on one of these buttons leads to additional menus showing members of that family. For example, clicking on “Beverages” leads to the list of beverages in FIG. 3. Accordingly, *Toth* discloses that food items can be placed into categories.

The act of showing a list of products that belong to a particular category does not amount to “using a set of rules to verify” that one of those products is in the same category as another product.

For example, if a customer were to click “iced tea” in FIG. 3, *Toth*’s system would simply place an order for iced tea. There is no indication that *Toth*’s system would respond to such a click by executing rules for determining whether a second physical product, i.e., iced tea, and a first physical product, i.e. a hamburger, are in the same family. Nor is there any indication that either of the cited references would carry out anything remotely like such a function.

Accordingly, even if one were to somehow combine all three references with each other, the result would still fail to disclose or suggest the claimed invention.

On page 54 of the Answer, the examiner simply states that the additional limitation of claim 32 “is disclosed and/or rendered obvious by the evidence relied upon.”

According to KSR,

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”⁴

A general statement that a particular claim limitation is “is disclosed and/or rendered obvious by the evidence relied upon.” is precisely the sort of conclusory assertion of an ultimate legal conclusion.

The examiner further states, on page 54, that *Toth* discloses product families and *D’Arbeloff* discloses transaction verification. The examiner then makes the conclusory assertion that it would have been obvious to combine these teachings to arrive at the claimed invention.

⁴ *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

This again is another example of the kind of conclusory statement forbidden by KSR. Essentially, the examiner is saying that the invention is obvious because he says so. This hardly rises to the level of “articulated reasoning with some rational underpinning” demanded by KSR.

SECTION 103 REJECTION OF DEPENDENT CLAIM 36

Claim 36 requires that the set of rules be “specific to at least one of a user who requests to redeem a product, a store where the request to redeem a product originates, a merchant associated a product to be redeemed, or a time when a request to redeem a product is made.”

The examiner states that *Toth* discloses this limitation at paragraph 74 and 22.

Paragraph 22 merely states that there exists a need for a system that guides the user through ordering and makes him feel as if the order has been properly entered and received. This has nothing to do with rules that are “specific to at least one of a user who requests to redeem a product, a store where the request to redeem a product originates, a merchant associated a product to be redeemed, or a time when a request to redeem a product is made.”

Paragraph 74 simply describes FIGS. 2 and 3, which show two layers of a hierarchical menu. The existence of two hierarchical menu layers has nothing whatsoever to do with rules that are “specific to at least one of a user who requests to redeem a product, a store where the request to redeem a product originates, a merchant associated a product to be redeemed, or a time when a request to redeem a product is made.”

On page 54 of the Answer, the examiner simply states that the additional limitation of claim 36 is “disclosed or rendered obvious by the evidence relied upon.”

This is yet another conclusory statement of the type forbidden by KSR. Once again, as he has done in connection with numerous claims, the examiner makes a statement that falls well short of “articulated reasoning with some rational underpinning.”

The examiner then states, on page 55 of the Answer, that the particular kinds of rules amount to “non-functional descriptive material.”

The limitation “the set of rules is specific to at least one of a user who requests to redeem a product, a store where the request to redeem a product originates, a merchant associated a product to be redeemed, or a time when a request to redeem a product is made” provides limitations on the kinds of rules covered by the claim. These limitations exclude various types of rules and thus function to narrow the scope of the claims.

The examiner may not read limitations out of the claims by simply dismissing them as “non-functional descriptive material.”

Moreover, the cited cases, *Gulack*, *Ngai*, and *Lowry*, all pertain to applications of the printed-matter doctrine, and whether such printed matter has a functional relationship with some substrate. A limitation concerning the nature of certain computer-implemented rules has nothing to do with this issue.

SECTION 103 REJECTION OF DEPENDENT CLAIM 35

Claim 35 recites the additional limitation of having the request to redeem a second product originate “from a point of sale terminal at a restaurant.”

The examiner asserts that *Toth* discloses this limitation at paragraph 74 and at paragraph 22.

Paragraph 22 merely states that there exists a need for a system that guides the user through ordering and makes him feel as if the order has been properly entered and received. This has nothing to do with having a request to redeem a second product originate “from a point of sale terminal at a restaurant.”

Paragraph 74 simply describes two layers of a hierarchical menu, shown in FIGS. 2 and 3. The existence of two hierarchical menu layers has nothing whatsoever to do with having a request to redeem a second product originate “from a point of sale terminal at a restaurant.”

Toth discloses using a POS at a restaurant. But *Toth*'s POS is only being used to order food. There is no teaching or suggestion in *Toth* of having a redemption request originate at a POS.

In response to the above arguments, on page 55 of the Answer, the examiner simply states that the additional limitation of claim 36 is "disclosed or rendered obvious by the evidence relied upon."

This is yet another conclusory statement of the type forbidden by KSR. Once again, as he has done in connection with numerous claims, the examiner makes a statement that falls well short of "articulated reasoning with some rational underpinning."

The examiner then states that "at a restaurant is non-functional descriptive material."

The cited references all pertain to whether there exists a functional relationship between printed matter and a substrate. A limitation associated with where a particular redemption request originates clearly has nothing to do with this issue.

SECTION 103 REJECTION OF CLAIM 55

The foregoing arguments raised in connection with claim 35 apply mutatis mutandis to claim 55.

Respectfully submitted,

Date: _____

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